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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,811	06/18/2001	Werner Lindemann	GR 00 P 12364	2553
24131	7590	11/05/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			NGUYEN, MINH CHAU	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/883,811	<b>Applicant(s)</b> LINDEMANN ET AL.	
	<b>Examiner</b> MINH-CHAU N. NGUYEN	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) 7-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/09/04, 08/19/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter, "checking a sender network address to determine whether a sender network address is intended for address conversion", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the specification, detail of checking is the address intended for address conversion is identified by the conversion identification ADR-MAP-FLAG (see section 0036 and 0043) to advance a skill in the art. Therefore, the Examiner will interpret "checking a sender network address" to mean checking the conversion identification Flag.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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1. Claim 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (Matsuzaki), (US 6,173,334 B1) in view of Cohen et al. (Cohen), (US 6,434,618 B1).

Regarding claim 1, Matsuzaki discloses the invention substantially as claimed.

Matsuzaki discloses a method of converting a network address, which comprises:

the sender network address is intended for address conversion, converting a received destination network address to a communications-device-internal network address (Matsuzaki teaches when the packet is received, the communication equipment of a LAN system of transmission source determines the destination address of the packet should be transferred to an external LAN system, if so it will transfer the packet to the communication equipment of the intermediate network and converts the IP address of destination to the address on the intermediate network), [Col. 9, L. 10-26].

Matsuzaki fails to disclose using an identification flag for indicating address conversion intention. However, Matsuzaki suggested that the terminal equipment checks the IP address of the terminal equipment of the partner destination to be communicated to determine whether the terminal equipment of the partner destination is in the other LAN system or the self LAN system, so that the IP address is need to be converted or not, such suggestion would motivate one ordinary skilled in the art to seek a practical and effective way of doing so. Cohen, in the same field of endeavor having closely related objectivity, teaches on receiving a message in a communication device, checking a sender network address to determine whether a

sender network address is intended for address conversion (Cohen teaches a received packet contains the SYN flag which the gateway can determine for an address translation needs to be performed), [Col. 6, L. 4-12].

Thus, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated a checking of conversion identification Flag to determine whether a network address is intended for address conversion, as suggested by Cohen, in the network address conversion of Matsuzaki in order to easily make an intention for the network address need to be converted.

Regarding claim 2, Matsuzaki-Cohen discloses the network address is an IP address (Matsuzaki teaches using IP address in order to identify individual terminals which are connected onto the network), [Col. 1, L. 16-19].

Regarding claim 3, Matsuzaki-Cohen discloses using a conversion address mask stored in a communication device to determine which parts of the destination network address need to be converted to the communication-device-internal network address (Matsuzaki teaches the address mapping information which is stored in the address mapping information storing portion of the communication equipments), [Col. 6, L. 13-26]

Regarding claim 4, Matsuzaki-Cohen discloses the checking step as to whether address conversion is to be carried out, on a list with network addresses intended for address conversion stored in the communications device (Matsuzaki teaches the address mapping information which is stored in the address mapping information storing portion makes the IP address of the terminal equipment of each LAN system defined in the LAN system correspond to the IP address of the terminal equipment of each LAN system defined in the intermediate network), [Col. 5, L. 50-56]

Regarding claim 5, Matsuzaki-Cohen discloses the checking step, as to whether address conversion is to be carried out, includes determining a route via which a link to the communications device has been set up (Matsuzaki teaches a communication equipment is generally in order to connect the LAN system and the intermediate network as a router, and routing information storing portions in which routing information has been stored. The routing information exchanges the network addresses, and constructs routing table in the communication equipment), [Col. 5, L. 34-50, and Col. 6, L. 59 – Col.7, L. 4].

Regarding claim 6, Matsuzaki-Cohen discloses the communications device is a communications system providing access to a computer network to be administered, and the method further comprises using the sender network address to identify a data processing device associated with a service center (Matsuzaki teaches the mapping of the IP address between the LAN system and the intermediate network is

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performed in the communication equipments and on the intermediate network; and a communication equipment as a service center which checks the network number of IP address of the terminal equipment of the partner destination to be communicated, thereby identifying whether the terminal equipment of in the self LAN system or the terminal equipment of the other LAN system), [Col. 2, L. 51-58; and Col. 8, L. 47-52; and figure 1]

2. Claim 7-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
3. The following is a statement of reasons for the indication of allowable subject matter: the prior arts of record, in singly or combination does not suggest, among other thing the network address conversion wherein converting the network address of the device connected to the computer network to a service-center-compatible virtual network address.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-CHAU N. NGUYEN whose telephone number is (703)305-8425. The examiner can normally be reached on Monday-Friday from 8:00am - 4:30pm.

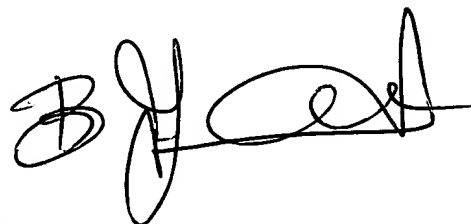
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID A. WILEY can be reached on (703)308-5221. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Bunjob Jaroenchonwant', with a stylized, cursive script.

**BUNJOB JAROENCHONWANT  
PRIMARY EXAMINER**